

Serial No. 10/757,753  
Reply to Office Action of July 19, 2005

### **REMARKS/ARGUMENTS**

Claims 1-38 were presented for examination and are pending in this application. In an Official Office Action dated July 19, 2005, claims 1-38 were rejected. The Applicants thank the Examiner for the withdrawal of previous rejections under 35 U.S.C. §101 and 35 U.S.C. §102 (Williams) and address the Examiner's comments concerning the claims pending in this application below.

Applicants herein amend claims 1, 14, 21-23 and 25. Claims 7, 10, 15 and 16 are hereby canceled without prejudice and no new claims are presently added. These changes are believed not to introduce new matter, and their entry is respectfully requested. In making this amendment, Applicants have not and do not narrow the scope of the protection to which the Applicants consider the claimed invention to be entitled and do not concede that the subject matter of such claims was in fact disclosed or taught by the cited prior art. Rather, Applicants reserve the right to pursue such protection at a later point in time and merely seek to pursue protection for the subject matter presented in this submission.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and withdraw them.

#### **I. Rejections under 35 U.S.C. §112**

Claims 1-14 were rejected under 35 U.S.C. §112. This rejection is respectfully traversed. The Office Action again questions how one would produce a probabilistically unique identifier without dividing the data file (a.k.a. digital sequence) into a plurality of pieces. The Applicants concur that the specification does describe an embodiment that divides a digital sequence into pieces having based commonality with other pieces. However, these techniques

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can be equally applied to arbitrarily large undivided files. Hence, the probabilistically unique identifier can be prepared from an arbitrarily large, undivided digital sequence as well as a divided digital sequence. Moreover, if the digital sequence were relatively small, further division of the sequence may not be practical. While the Applicants contend that division is not necessarily required in all embodiments to create a probabilistically unique identifier of a digital sequence, the Applicants have amended claim 1 as requested by the Examiner in an effort to expedite prosecution of the application.

The Examiner also suggests that the unique identifiers should be limited to a hashing function. The probabilistically unique identifier recited in claims 1 and 14 can be produced through dissimilar operations. As recited in claim 1 and claim 14 respectively, the probabilistically unique identifier can be produced by hashing or a checksum respectively, or any other equivalent technique.

The Office Action further states that the probabilistically unique identifier can only compare with a previously stored identifier on the list. Claims 1, 14 and 25 were previously amended to identify a "previously stored list" of probabilistically unique identifiers. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. §112 be withdrawn.

Lastly, claims 1-24 were rejected under 35 U.S.C. §112, second paragraph, as omitting essential steps. As aforementioned, claims 1 and 14 have been amended to overcome this rejection. It is respectfully requested that the rejections under 35 U.S.C. §112 be withdrawn.

## **II. Double Patenting.**

Claims 1-38 were rejected under the judicially created doctrine of Double Patenting.

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Although the claims as presented are believed to be distinct with respect to U.S. Patent 6,704,730, a terminal disclaimer will be supplied together with the required fee upon indication of allowable subject matter. Accordingly, it is respectfully requested that the double patenting rejection be held in abeyance.

### **III. 35 U.S.C. §103(a) Obviousness Rejection of Claims**

Claims 1-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,219,423 ("Davis") in view of U.S. Patent No. 5,990,810 ("Williams"). Applicants respectfully traverse these rejections in light of the aforementioned remarks and respectfully requests reconsideration.

MPEP §2143 provides:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The cited references fail to teach or suggest all of the limitations recited in the claims as currently amended. For example, independent claim 1 recites, "comparing said probabilistically unique Identifier for each of the plurality of digital sequences to similarly produced probabilistically unique identifiers corresponding to a previously stored list of digital sequences, and maintaining a list of probabilistically unique identifiers based upon the act of comparing."

Davis in view of Williams does not teach or suggest operating on a previously stored list of digital sequences to determine probabilistically unique

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identifiers for each item in the list using operations such as, for example, a hash value as in claim 1 or a checksum as in claim 14, and then comparing those newly determined probabilistically unique identifiers to the probabilistically unique identifiers for the plurality of digital sequences. Davis in view of Williams also fails to teach or suggest comparing the probabilistically unique identifiers for the plurality of digital sequences to a previously stored list of unique identifiers (hash values or checksums). Based on these comparisons, the present invention updates and maintains a list of unique identifiers and data for future comparisons. This aspect again appears not to be taught or suggested by Davis or Williams. The Examiner is directed to page 23, second and third paragraph of the specification which supports and further outlines these novel features of the Applicants' invention.

Davis in view of Williams fails to teach or suggest each and every limitation recited in the claims. Accordingly, the Applicants respectfully submit that independent claims 1, 14 and 25 are patentable over Davis in view of Williams and request that the rejections be withdrawn. Claims 2-6, 8-9, 11-13, 17-24 and 26-38 depend from claims 1, 14 and 25 respectively and are, for at least the same reasons, patentable over Davis in view of Williams.

The Applicants also reiterate their argument that Davis is not properly combinable with Williams. While the cited portion of Williams teaches the adding and removing of subblocks to/from a collection, it is not clear how this teaching in Williams would be combined with Davis to show or suggest that these subblocks are the same as the probabilistically unique identifiers called for in the instant claims. Moreover, the motivation to combine the references stated in the Office Action (i.e., "for the purpose of reducing redundancy by increasing the efficiency of systems that store and communicate data") has no bearing on the Davis system. In the Davis system, redundancy appears mandatory as each signatory

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signatory transmits a uniquely encoded version of the same document to an arbiter. Eliminating redundancy would prevent the arbiter from knowing that everyone signed the same documents. Because the Office Action does not state sufficient motivation to support the combination, it is respectfully requested that the rejection of claims 2-38 under 35 U.S.C. §103 be withdrawn.

In view of all of the above, the claims are now believed to be allowable and the case in condition for allowance which action is respectfully requested. Should the Examiner be of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

No fee is believed due for this submittal. However, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,

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Michael C. Martensen, No. 46,901  
Hogan & Hartson LLP  
One Tabor Center  
1200 17th Street, Suite 1500  
Denver, Colorado 80202  
(719) 448-5910 Tel  
(303) 899-7333 Fax